

REMARKS

Claims 1-2, 4-12, 15, and 16 are pending in the Application. Claims 3, 13 and 14 have been cancelled. The specification has been amended. No new matter has been added.

ELECTION

The Office Action requests a restriction of the claims in the application as follows:

- I. Claims 1, 2, 4-12, 15 and 16, drawn to a composition comprising polyamide and graft polymer, classified in class 524, subclass various.
- II. Claims 3, 13 and 14, drawn to a composition comprising polyamide, graft polymer and additional polymer, classified in class 524, subclass various.

The restriction is based on the grounds that inventions of groups I and II are related as mutually exclusive species in an intermediate-final product relationship.

Applicants traverse the rejection because the Examiner has not made a showing to support the asserted reasons for the restriction which are rather general. Applicants, therefore, request that the Examiner present a showing of a prima facie case supporting the restriction.

Nonetheless, Applicants hereby elect the claims of Group I, with traverse.

In view of the foregoing amendments and remarks, examination of the claims is requested.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims of copending Application Nos. 10/719,720, 10/737,321 and 10/796,525.

The Office Action alleges that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter" (Office Action, page 6, lines 1-2).

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However, although Application Nos. 10/719,720, 10/737,321 and 10/796,525 may include some subject matter of Applicants' invention, the Application Nos. 10/719,720, 10/737,321 and 10/796,525 do not teach or suggest all of the elements of Applicants' invention. Reconsideration is requested.

REJECTIONS UNDER 112

Claims 1-16 have been rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claims 1 and 4, the Specification provides support for "graft polymers" of Applicants' invention on pages 8-11. Thus, one reading the claims in light of the Specification would not be able to make Applicants' invention.

Regarding Claims 2 and 4, mineral particles are distinguished from carbon particles at pages 12-15 and 15-18, respectively. Thus, the terms are not the same entity as alleged by the Office Action.

Regarding Claim 3, Claim 3 has been cancelled.

Regarding Claim 6, Claim 6 includes "at least one monomer selected from the group B.1.1" and "at least one monomer selected from the group B.1.2." Reconsideration of the rejections Under 35 USC 112, second paragraph is requested.

REJECTIONS UNDER 103

1. Claims 1-4, 10-12, 15 and 16 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 103 as being obvious in view of EP '386. The rejection should be withdrawn in view of the remarks below.

Claims 1, 2, 4-12, 15 and 16 are pending in the Application. Claim 3 has been cancelled. Applicants' invention is related to a molding composition containing polyamide, electrically conductive carbon in particulate form and a graft polymer, the sum of the parts by weight of the polyamide, conductive carbon and graft polymer totalling 100.

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The Office Action alleges that:

"The disclosure of the reference meets the requirements of the above-rejected claims both in terms of the types of materials added and their contents. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference."

The Office Action also alleges that, "a modified polyphenylene ether reads on the applicants' generically claimed 'graft' polymer."

However, EP'386 teaches a composition that requires a polyphenylene ether whereas Applicants' invention does not include such a component or derivatives thereof. In fact, Applicants' invention is related to the polyamide, electrically conductive carbon, graft polymer (and mineral particles) totalling 100 parts by weight.

Further, Applicants' invention includes a graft polymer which is not generically claimed. A graft polymer comprises a random (co)polymer formed from vinyl monomers B.1, preferably according to B.1.1 and B.1.2, and also a rubber B.2 that has been grafted with vinyl monomers, preferably according to B.1.1 and B.1.2 and is described in the Specification at pages 8-11.

Thus, EP '386 does not teach or suggest Applicants' invention. Reconsideration is requested.

2. Claims 5-9 and 14 stand rejected under 35 USC 103 as being unpatentable over EP 050 6386. The rejection should be withdrawn in view of the remarks below.

Claims 5-9 and 14 depend from Claim 1, either directly or indirectly, which as discussed is believed to be allowable. Thus, Claims 5-9 and 14 are also believed to be allowable.

Further, the Office Action alleges that:

"In essence, the disclosure of the reference differs from the above-rejected claims in not expressly exemplifying the use of applicants' preferred graft polymer. In this regard, it is noted that graft polymers meeting applicants' specific requirements can be used in place of the SBS block copolymer of the

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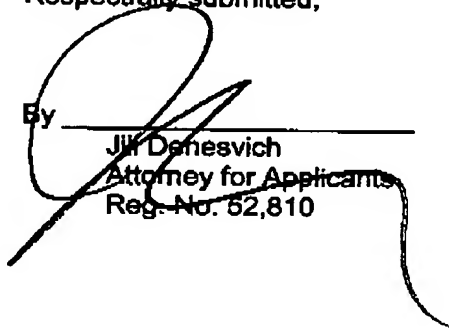
examples with the reasonable expectation of success (page 5, lines 1-5). Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter."

However, EP '386 does not teach or suggest Applicants' invention including a graft polymer. As the Office Action already alleged, the SBS block copolymer is just a "further component" (Office Action, page 4, section 8, lines 6 and 7) and is not a graft polymer of Applicants' invention. Reconsideration is requested.

In view of the above amendments, Applicants submit that the claims are in condition for allowance and the Examiner would be justified in allowing them.

Respectfully submitted,

By


J. J. Denesvich
Attorney for Applicants
Reg. No. 52,810

LANXESS Corporation
Law & Intellectual Property Department
111 RIDC Park West Drive
Pittsburgh, Pennsylvania 15275-1112
(412) 809-2232
FACSIMILE PHONE NUMBER:
(412) 809-1054

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